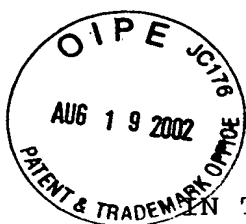


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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Y. NAGAI et al.
Serial No.: 09/290,251
Filed: April 13, 1999
For: REPRODUCTION APPARATUS AND REPRODUCTION
METHOD OF DIGITAL VIDEO SIGNAL OR AUDIO
SIGNAL
Art Unit: 3625
Examiner: N. Rosen

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GROUP 3600

REPLY BRIEF

Assistant Commissioner for Patents
Washington, D.C. 20231

August 19, 2002

Sir:

In connection with the above-identified application, this Reply Brief is being submitted in triplicate in response to the Examiner's Answer of June 18, 2002.

A Request for Oral Hearing is being submitted herewith, together with a credit card payment form in payment of the fee of \$280.00 required for filing the Request for Oral Hearing.

REMARKS

In section (5) entitled "Summary of Invention" on pages 2-3 of the Examiner's Answer of June 18, 2002, the Examiner states as follows:

The summary of invention contained in the brief is deficient because the appellant confusingly states that it is not possible for a signal for which copying once was permitted to exist in a

DVD-ROM disk (page 5 of the Appeal Brief, lines 1-6). Such a signal can in fact exist on a DVD-ROM disk, as appellant states elsewhere (page 5 of the Appeal Brief, lines 12-14; see also the specification, page 2, line 21, through page 3, line 17). Such a signal on a DVD-ROM disk is evidence that unauthorized copying has taken place, but it is quite possible. A violation of the copyright laws is not a violation of the laws of logic or physics.

Reference is made to page 2, lines 21-25, of the specification which reads as follows:

Originally, a medium allowing copying only once does not exist in DVD-ROM disks. In other words, it is impossible in DVD-ROMS to detect information which has permitted copying of only one generation, from video data.

The point the appellants are trying to make in the portion of the Appeal Brief of April 29, 2002, referred to by the Examiner is that it is not possible for a signal for which copying once was permitted to legally exist in a DVD-ROM disk because the signal could not have been recorded directly onto the DVD-ROM disk because the DVD-ROM disk is not a recordable medium, but is a medium dedicated to reproduction, and therefore any DVD-ROM which has recorded thereon a signal for which copying once was permitted is an illegal copy. The appellants make this clear in their subsequent statement in the Appeal Brief which reads as follows:

Thus, a medium which is dedicated to reproduction and has recorded thereon a signal for which copying once was permitted is an illegal copy.

The appellants' invention prevents reproduction of such an illegal copy by detecting (1) that a signal recorded on a

medium is a signal for which copying once was permitted and
(2) that the medium is a medium dedicated to reproduction,
thereby detecting that the medium contains an illegal copy,
and then stopping reproduction of the illegal copy.

In section (6) entitled "Issues" on page 4 of the Examiner's Answer, the Examiner disputes the position taken by the appellants in the Appeal Brief that the Examiner improperly relied on Park '826 to support the rejection of claims 2-3, 5, 7, 15, 25-26, 28, 30, and 37 without including Park '826 in the statement of the rejection as required by the decision of In re Hoch, and states that the Examiner expressly disclaimed any reliance on Park '826 on pages 33-34 of the final Office Action of October 31, 2001. If this is the case, it is submitted that the Examiner should have deleted any reference to Park '826 in the final Office Action, which would have avoided the confusion as to whether or not the Examiner has actually relied on Park '826. Since the Examiner did not do this, the appellants chose to err on the side of caution and take the position that the Examiner has in fact relied on Park '826, but has done so improperly, thereby making it unnecessary for the appellants to address the Examiner's comments about Park '826. In any event, the appellants acknowledge the Examiner's explicit statement on the record in the Examiner's Answer that the Examiner did not rely on Park '826 in the final Office Action or the Examiner's Answer.

In section (7) entitled "Grouping of Claims" on pages 3-4 of the Examiner's Answer, the Examiner states as follows:

The appellant's statement in the brief that certain claims do not stand or fall together is not agreed with because, although certain claims are significantly different from each other, and do not stand or fall together, others are closely parallel. In particular, independent claim 14 recites a method closely parallel to the apparatus claim 1, and claim 16 recites a computer-readable program closely parallel to claims 1 and 14. Examiner applied the same rejection to claims 14 and 16 as to claim 1. Similarly, claim 24 depends on claim 1; claims 36 and 38 depend on claims 14 and 16, respectively, and are closely parallel on claim 24. Examiner applied the same rejection to claims 36 and 38 as to claim 24. Examiner therefore believes that independent claims 1, 14 and 16 stand or fall together, as do dependent claims 24, 36, and 38. Appellants provide no arguments why these claims subject to the same rejection are separately patentable, instead writing that claims 14, 16, 24, 36, or 38 should be allowed for at least substantially the same reasons discussed with regard to claim 1.

As recognized by the Examiner, claims 1, 14, and 16 are not identical to one another, and claims 24, 36, and 38 are not identical to one another. The Examiner did not group claims 1, 14, and 16 together in explaining the rejection of these claims in either the final Office Action or the Examiner's Answer, and did not group claims 24, 36, and 38 together in explaining the rejection of these claims in either the final Office Action or the Examiner's Answer. Likewise, the appellants did not group claims 1, 14, and 16 together in traversing the rejection of these claims in the Appeal Brief, and did not group claims 24, 36, and 38 together in traversing the rejection of these claims in the Appeal Brief.

The appellants did not merely state in the Appeal Brief that "claims 14, 16, 24, 36, or 38 should be allowed for at least substantially the same reasons discussed with regard to claim 1" as alleged by the Examiner. Rather, the appellants individually identified specific limitations of each of claims 1, 14, 16, 24, 36, and 38 which are not disclosed or suggested by the references relied on by the Examiner, thereby providing separate arguments with respect to the patentability of each of claims 1, 14, 16, 24, 36, and 38 as required by 37 CFR 1.192(c)(7) and 1.192(c)(8)(iv).

Accordingly, for the reasons discussed above, the appellants maintain their position as set forth in the Appeal Brief that none of claims 1-16 and 24-38 on appeal stand or fall together, and that each of claims 1-16 and 24-38 is considered to be separately patentable.

In section (11) entitled "Response to Argument" on pages 36-37 of the Examiner's Answer, the Examiner states as follows:

Appellants' choice of terminology is not ideal. Appellants use the expression "recordable medium" to refer a medium such as a DVD-RAM disk, and "medium dedicated to reproduction" to refer to a medium such as a DVD-ROM (read only memory) disk. RAM disks are indeed recordable, in that new data can be recorded on them; ROM disks are not recordable, and are normally manufactured by pressing with impressions representing data permanently embedded into them. However, while the data on a ROM disk can be reproduced (played, or copied to a RAM disk), so can the data on a RAM disk, so ROM disks are not the only "media dedicated to reproduction." "Non-recordable medium" might be a better term. Secondly, ROM disks may have copy

protection features to prevent them from being reproduced, as taught in the instant application (Summary of Invention, pages 2 and 3) and in such prior art as Linnartz (column 5, line 54, through column 6, line 54). Referring to pressed or ROM disks as "media dedicated to reproduction" is questionable when they incorporate features specifically to prevent their content from being reproduced. It is suggested that the honorable members of the Board keep in mind what Appellants' terms refer to.

It is submitted that it is highly improper for the Examiner to object to the appellants' choice of terminology as being "not ideal" or "questionable" for the first time in the Examiner's Answer after failing to raise this issue in any of the six Office Actions of November 26, 1999; June 12, 2000; January 19, 2001; May 22, 2001; October 11, 2001; and October 31, 2001. Furthermore, reference is made to MPEP 2173.02, Eighth Edition, August 2001, page 2100-194, which provides as follows in pertinent part (emphasis added):

The examiner's focus during examination of claims for compliance with the requirement for definiteness of 35 U.S.C. 112, second paragraph is whether the claim meets the threshold requirements of clarity and precision, not whether more suitable language or modes of expression are available.

Furthermore, it is submitted that the term "medium dedicated to reproduction" clearly and precisely describes a DVD-ROM. The Examiner's objection to this term appears to be that since a DVD-RAM disk can reproduce data as well as a record data, then a DVD-RAM disk is also a medium dedicated to reproduction. However, in taking this position, the Examiner has ignored the plain English meaning of the word "dedicate",

which is to set apart for a special use. Thus, a medium dedicated to reproduction is a medium which is set apart for reproducing data, i.e. which a medium which only reproduces data, or a medium which only has the capability of reproducing data, such as a DVD-ROM. Thus, a DVD-RAM which both records and reproduces data cannot in any way be described as a medium dedicated to reproduction as alleged by the Examiner.

Another reason for the Examiner's objection to the term "medium dedicated to reproduction" is that the Examiner is of the opinion that DVD-ROM disks may have copy protection features to prevent them from being reproduced, and that when a DVD-ROM is prevented from being reproduced, it is no longer a medium dedicated to reproduction. However, it is submitted that whether a medium is a medium which is dedicated to reproduction is a physical characteristic of the medium which does not change depending on whether the medium is allowed to be reproduced or prevented from being reproduced.

Furthermore, with respect to the Examiner's statement that "ROM disks may have copy protection features to prevent them from being reproduced, as taught in the instant application (Summary of Invention, pages 2 and 3) and in such prior art as Linnartz (column 5, line 54, through column 6, line 54)", it is noted that the "Summary of Invention, pages 2 and 3" is the appellants' summary of their invention in the specification of the present application, and the appellants have disclosed their invention using the term "medium dedicated to reproduction", such that this term is in fact

consistent with ROM disks having copy protection features to prevent them from being reproduced.

Furthermore, with respect to column 5, line 54, through column 6, line 54, of Linnartz, although this passage of Linnartz mentions professionally released discs/storage media which may have a medium mark carrying a predetermined value of P, and mentions preventing reproduction of a medium if a watermark in a stream of data read from the medium does not match $F^m(T)$, it is submitted that this passage of Linnartz does not specifically mention ROM disks, or that reproduction of any medium is prevented based on a determination that the medium is a medium dedicated to reproduction.

ISSUE 1

In section (11) entitled "Response to Argument" on pages 37-38 of the Examiner's Answer, the Examiner states as follows (emphasis added):

With regard to the first issue, and with regard to claim 1 in particular, Appellants set forth the question in dispute at considerable length, and argue their position. Examiner will not attempt to reply at equal length, particularly since substantial extracts from the rejection and response to arguments in Examiner's final Office Action are quoted in Appellants' Appeal Brief. The fundamentals are as follows: Appellants claim a reproduction apparatus comprising a reproducing unit, a determining unit, and a stopping unit. Linnartz, the primary reference, discloses a reproducing unit. Linnartz discloses a determining unit which determines whether the medium to be reproduced is a recordable medium (column 5, lines 54-66; column 7, lines 4-13), but does not clearly and expressly

disclose determining whether the medium to be reproduced is dedicated to reproduction or to recording. It is to be noted, however, that Linnartz recites, "A copy control concept is disclosed that relies on physical marks on the medium . . . and a copy control ticket that is represented as a digital number." (Column 7, lines 4-7.) Also, "Recordable media may carry a fixed predetermined medium mark identifying the medium as recordable, or as a professional disc from a known source." (Column 5, lines 61-63.) Linnartz goes on to disclose "A medium mark P that is present on professionally released discs/storage media; recordable media carry a predetermined value of P," (column 6, lines 2-4) and to state, "The player only provides F(T) to the recorder if the player reads from an original disc, i.e., with a valid P matching T." T is the copy control ticket (column 6, lines 17-21), and F(T) is essential to determining whether reproduction is allowed (column 6, line 22, through column 7, line 9), so Linnartz teaches that the medium mark, which can indicate whether the medium is recordable or dedicated to reproduction, is used in judging whether to stop reproduction. Linnartz falls short of anticipating claim 1 only because Linnartz is not fully explicit in stating that an invalid medium mark P is a P indicating that the medium is a medium dedicated to reproduction.

As pointed out by the Examiner, Linnartz uses the medium mark P to determine whether the disc to be reproduced is an original disc, not whether the disc is a disc which is dedicated to reproduction, and stops reproduction if the disc is not an original disc. In contrast, the present invention stops reproduction if it is determined that (1) copying once was permitted and (2) the medium is a medium which is dedicated to reproduction.

In section (11) entitled "Response to Argument" on pages 38-39 of the Examiner's Answer, the Examiner states as follows (emphasis added):

Thus, while the Linnartz patent does not clearly and expressly disclose determining whether the medium to be reproduced is dedicated to reproduction or to recording, it comes very close, since the "predetermined medium mark" can be used to determine whether the medium is recordable, or else a professionally manufactured disc, and thus, in Appellants' terminology, dedicated to reproduction. Doi does expressly disclose determining whether a medium is dedicated to reproduction or recording (column 13, lines 46-55). Examiner held the combination of Linnartz with Doi to be obvious to one of ordinary skill in the art of copy protection; Appellants dispute that. Appellants argue that nothing in Doi suggests stopping reproduction in response to a result indicating that the medium is a medium dedicated to reproduction "as alleged by the Examiner" (the Appeal Brief, page 13). It is true that Doi does not suggest stopping reproduction in response to a result indicating that the medium is a medium dedicated to reproduction, but Examiner never alleged any such teaching in Doi. Rather, Examiner relied on Linnartz's disclosure of a stopping unit which stops reproduction in response to the information reproduced by the reproducing unit indicating that copying once was permitted (column 3, lines 17-67; column 4, line 58, through column 5, line 2; column 6, lines 22-45). Linnartz does not expressly disclose stopping reproduction in response to determining that the medium is a medium dedicated to reproduction, but, as set forth in the preceding paragraph, Linnartz's use of a medium mark for determining whether to enable or stop reproduction comes close; and Examiner held stopping reproduction in response to determining that the medium is a medium dedicated to reproduction to be obvious for the advantage of limiting the

reproduction of proprietary information,
which is the goal of Linnartz's invention.

The important thing to note in this passage is the Examiner's repeated admission that Linnartz only comes very close to disclosing stopping reproduction in response to a determination that a medium is a medium dedicated to reproduction as recited in claim 1.

As pointed out by the Examiner, Linnartz discloses using a medium mark to determine whether to stop reproduction, but does not determine whether the medium mark indicates a medium dedicated to reproduction, and Doi discloses determining whether a medium is dedicated to reproduction, but does not disclose stopping reproduction in response to a determination that a medium is a medium dedicated to reproduction.

Furthermore, although Linnartz discloses that the medium mark may indicate a professionally manufactured disc as pointed out by the Examiner, it is not seen where anything whatsoever in Linnartz supports the Examiner's position that such a professionally manufactured disc is a medium dedicated to reproduction.

Thus, while Linnartz and Doi provide bits and pieces of the feature of the present invention wherein reproduction is stopped in response to a determination that a medium is a medium dedicated to reproduction, as recognized by the Examiner, these two references, even when combined, do not disclose this feature of the present invention, and the only way the Examiner can provide this feature of the present invention using Linnartz and Doi is to simply hold that

stopping reproduction in response to a determination that a medium is a medium dedicated to reproduction as recited in claim 1 is obvious for the advantage of limiting the reproduction of proprietary information, which is the goal of Linnartz's invention. However, it is submitted that the Examiner cannot use this advantage provided by Linnartz's invention as a basis for holding this feature of the present invention to be obvious because Linnartz's invention already achieves its goal of limiting the reproduction of proprietary information without using this feature.

It is submitted that nothing whatsoever in Linnartz even recognizes the problem solved by the present invention, i.e. preventing reproduction of an illegal copy of a copy once permitted signal on a medium dedicated to reproduction manufactured by pressing from a master made from a legal copy of the copy once permitted signal recorded onto a recordable disk. Since Linnartz does not even recognize this problem, it is submitted that it would not have been obvious to modify Linnartz to stop reproduction in response to a determination that a medium is a medium dedicated to reproduction as alleged by the Examiner.

In section (11) entitled "Response to Argument" on pages 39-40 of the Examiner's Answer, the Examiner states as follows (emphasis added):

Appellants next argue that that the motivation to combine Linnartz and Doi was found only in the Appellants' disclosure, and is therefore impermissible hindsight reasoning. Examiner disagrees. The basic purpose of Linnartz's invention is to

prevent or limit unauthorized copying, and Linnartz discloses - as background prior art - that "Other copy bits may indicate that the medium containing the information is a 'professional' medium manufactured by pressing, and is not a 'recordable' disc" (column 1, lines 45-65). It is difficult to see what purpose these "other copy bits" may have had, unless to determine whether copying was authorized, or what benefit there was in determining whether copying was authorized, unless unauthorized reproduction was to be stopped; and Linnartz, as noted, expressly discloses stopping unauthorized copying. As set forth above, Linnartz goes on to disclose the use of a medium mark P in his own invention, for the same purpose of stopping unauthorized reproduction (column 5, line 54, through column 7, line 9). Thus, there is motivation to combine the teachings of Doi with those of Linnartz, both in Linnartz, and in the knowledge generally available to one of ordinary skill in the prior art, as admitted background of the primary reference.

However, it is submitted that the Examiner's statement that "[i]t is difficult to see what purpose these 'other copy bits' may have had, unless to determine whether copying was authorized, or what benefit there was in determining whether copying was authorized, unless unauthorized reproduction was to be stopped" in this passage is pure speculation on the Examiner's part, and that the only source for the Examiner's conclusion about the purpose of the "other copy bits" is the appellants' disclosure which discloses stopping reproduction in response to a determination that a medium is a medium dedicated to reproduction.

Furthermore, it is submitted that the "other copy bits" referred to by the Examiner are in fact the L-bit described in International Standard IEC 60958-3 for the reasons discussed

on pages 18-26 of the Appeal Brief which is used in stopping recording of an input signal, rather than stopping reproduction in response to a determination that a medium is a medium dedicated to reproduction.

In section (11) entitled "Response to Argument" on pages 40-41 of the Examiner's Answer, the Examiner states as follows (emphasis added):

Appellants devote several pages to the DCC (digital compact cassette) copy protection system mentioned as background in Linnartz, declaring it to be the Serial Copy Management System (SCMS) referred to in 17 U.S.C. 1002(a) and described in International Standard IEC 60958-3. Appellants argue the SCMS is concerned solely with stopping copying of a signal which is not permitted to be copied, rather than stopping reproduction of a copied signal for which copying once was permitted and which is recorded on a medium dedicated to reproduction, as recited in claim 1 (Appeal Brief, page 24, lines 16-24). Examiner responds that this argument overlooks two important points. The first is that Linnartz, in his background discussion, briefly describes the DCC copy protection system, with "copy bits" indicating a copy status of "no copy allowed", "free copy", or "one generation of copy allowed" (column 1, lines 59-62), and then refers to "Other copy bits" which may indicate whether the medium to be copied is a "professional" medium manufactured by pressing or a "recordable" disc. The second point is that the DCC/SCMS system is prior art disclosed as background by Linnartz; what Linnartz describes and claims as his invention goes beyond the DCC/SCMS system. In particular, the "no copy allowed" status in the SCMS does not necessarily mean that copying once was permitted, but Linnartz discloses a system where the status of a signal does indicate that copying once was permitted, but is longer permitted, the maximum allowable number of generations of copies having been made (column 3, lines

17-67; column 4, line 58, through column 5, line 2; column 6, lines 22-45). This is why Examiner made new rejections based on Linnartz as the primary reference after Appellants' representative, in a personal interview, made a persuasive case that Tozaki did not quite provide grounds for rejection (referred to on page 23 of the Appeal Brief).

It appears from the Examiner's comments that the Examiner is of the opinion that the "other copy bits" disclosed in Linnartz are not part of the DCC/SCMS system. However, it is submitted that the "other copy bits" referred to by the Examiner are in fact the L-bit described in International Standard IEC 60958-3 for the reasons discussed on pages 18-26 of the Appeal Brief which is used in stopping recording of an input signal, rather than stopping reproduction in response to a determination that a medium is a medium dedicated to reproduction.

Furthermore, it is submitted that most of the Examiner's comments in this passage are irrelevant because they do not address the issues raised by the appellants, which are directed to the Examiner's speculation that the "other copy bits" disclosed in Linnartz are used to stop reproduction in response to a determination that a medium is a medium dedicated to reproduction as recited in claim 1 as discussed above.

In section (11) entitled "Response to Argument" on pages 41-42 of the Examiner's Answer, the Examiner states as follows:

Next, Appellants refer to Table C.1 on page 55 of IEC 60958-3 (Appeal Brief, page

24, line 25, through page 25, line 13) and argue that what is disclosed there does not provide grounds to reject claim 1. Examiner responds that this is irrelevant; claim 1 was not rejected as obvious over IEC 60958-3, nor (in the last Office Action) over Tozaki, but over Linnartz in view of Doi. The next several pages of the Appeal Brief (through page 27) simply recapitulate and reiterate Appellants' arguments, which are already treated above.

However, it is submitted that the discussion of Table C.1 of IEC 60958-3 and Tozaki is not irrelevant as alleged by the Examiner, and that the appellants did not argue that Table C.1 does not provide grounds to reject claim 1.

Rather, what the appellants have done in the discussion of Table C.1 and Tozaki is to show that Table C.1 discloses what is the actual purpose of the "other copy bits" in Linnartz referred to by the Examiner, which is stopping reproduction of an input signal, and to show that Tozaki confirms the appellants' interpretation of Table C.1, thereby showing that the Examiner's speculation that the "other copy bits" in Linnartz are used to stop reproduction in response to a determination that a medium is a medium dedicated to reproduction is incorrect.

Accordingly, for the reasons discussed above and on pages 7-27 of the Appeal Brief, it is submitted that Linnartz and Doi do not disclose or suggest a determining unit which determines whether the medium to be reproduced is a medium dedicated to reproduction or a recordable medium, and a stopping unit which stops reproduction in response to the information reproduced by said reproducing unit indicating

that copying once was permitted and a result of the determining by said determining unit indicating that the medium is a medium dedicated to reproduction as recited in claim 1.

ISSUE 2

In section (11) entitled "Response to Argument" on pages 46-47 of the Examiner's Answer, the Examiner states as follows (emphasis added):

The second major issue of the case is whether claims 2-3, 5, 7, 15, 25-26, 28, 30, and 37 should be rejected as unpatentable over Linnartz in view of Doi, Tozaki, and Mardirossian

Claim 2 bears some resemblance to claim 1, but also recites an error correction unit which conducts error correction according to an added error correction code, and recites a destroying unit rather than a stopping unit. Appellants submit that Linnartz and Doi do not disclose or suggest a determining unit which determines whether the medium to be reproduced is a medium dedicated to reproduction or a recordable medium; Examiner responds that Doi quite explicitly discloses exactly this, while Linnartz refers to "Other copy bits" which may indicate whether the medium is a "professional" medium or a "recordable" disc (column 1, lines 63-65). Appellants submit that Linnartz and Doi do not disclose a destroying unit according to the limitations of claim 2, as indeed Linnartz and Doi do not, but Appellants go on to write "Nor is it seen where Tozaki, Mardirossian, and Park '826 disclose or suggest these features of claim 2." In rejecting claim 2, Examiner set forth where Mardirossian teaches destroying data to prevent unauthorized copying, namely the Abstract and column 5, lines 12-35. Hence, it can scarcely be maintained, in view of Mardirossian, that it is unknown

to destroy data in order to prevent unauthorized copying.

However, the appellants did not argue that Mardirossian does not disclose destroying data in order to prevent unauthorized copying as apparently alleged by the Examiner. Rather, the appellants pointed out that claim 2 recites a destroying unit which destroys reproduced data, while the abstract (as well as column 5, lines 12-35) of Mardirossian discloses destroying recorded data on a disk.

In section (11) entitled "Response to Argument" on pages 47-48 of the Examiner's Answer, the Examiner states as follows (emphasis added):

Appellants further argue that Mardirossian discloses destroying recorded data on a disk, rather than destroying reproduced data However, Examiner did not contend that Mardirossian . . . discloses destroying precisely the same data in the same circumstances as recited in claim 2. The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). In this case, the teachings of Mardirossian would have suggested to those of ordinary skill in the art that data may be destroyed in order to prevent or limit unauthorized copying, because Mardirossian discloses destroying data to prevent unauthorized copying. As the basis and purpose of Linnartz, the primary reference, is to prevent unauthorized copying (while enabling unauthorized copying), Mardirossian is clearly analogous art, and the combination of references suggests destroying data so as

to make contents whose reproduction is unauthorized impossible to reproduce.

However, in the combined teachings of Linnartz, Doi, and Mardirossian, the only suggestion to destroy data is found in Mardirossian, and the only way Mardirossian teaches to destroy data is to destroy recorded data on a disk, thereby preventing unauthorized copying of the data on the disk.

In contrast, Linnartz discloses preventing unauthorized copying by stopping reproduction of data on a disk when certain conditions are met, although it is submitted that Linnartz, Doi, and Mardirossian do not disclose or suggest stopping reproduction in response to a determination that a medium is a medium dedicated to reproduction as recited in claim 1 for the reasons discussed above, or destroying reproduced data in response to a determination that a medium is a medium dedicated to reproduction as recited in claim 2 for substantially the same reasons.

Accordingly, if Mardirossian's technique were to be incorporated into Linnartz's apparatus, it is submitted that this would result in recorded data on Linnartz's disk being destroyed to prevent unauthorized copying of the recorded data. It is submitted that there is simply no suggestion whatsoever in Linnartz, Doi, and Mardirossian or in the knowledge generally available to one of ordinary skill in the art to modify Mardirossian's only disclosed technique of destroying recorded data on a disk to instead destroy reproduced data reproduced by Linnartz's apparatus as proposed by the Examiner.

Accordingly, for the reasons discussed above and on pages 41-45 of the Appeal Brief, it is submitted that Linnartz, Doi, Tozaki, and Mardirossian do not disclose or suggest a determining unit which determines whether the medium to be reproduced is a medium dedicated to reproduction or a recordable medium, and a destroying unit which destroys reproduced data so as to make the video data and/or audio data non-reproducible in response to the information reproduced by said reproducing unit indicating that copying once was permitted and a result of the determining by said determining unit indicating that the medium is a medium dedicated to reproduction as recited in claim 2.

ISSUE 3

In section (11) entitled "Response to Argument" on pages 51-53 of the Examiner's Answer, the Examiner states as follows (emphasis added):

The third and last major issue in the case is whether claims 12-13 and 34-35 should be rejected as unpatentable over Linnartz in view of Yokota (Yokota et al., U.S. Patent 5,633,841) and Fox (the abstract of the article, "Wobble Drives Pirates off the Digital Seas"). . . .

. . . .

Appellants argue that Copeland (U.S. Patent 5,659,513) and the Fox abstract (the Fox article refers to Copeland's invention) disclose that the disk dedicated to reproduction has wobbled grooves, and that the recorded disk has no wobbled grooves, which is exactly the opposite of the situation recited in claim 12, which recites that said medium dedicated to reproduction has no wobbled

grooves, and that said recordable medium has wobbled grooves. Examiner responds that there are several weak points in this argument. First, it is to be noted that, according to the final four lines of claim 12, reproduction is to be stopped if a wobble is not detected; Fox teaches that playing is to be allowed if a wobble is detected, and prevented if a wobble is not detected; therefore, there is an important similarity in the ways that claim 12 and Fox use wobbles. In both, the detected presence of wobbles allows an operation to occur, the absence thereof stops the operation. Therefore, it is held to be the fair teaching of Fox that wobbles must be detected on a disk for an operation, such as reproduction, to be judged as authorized and allowed to proceed. Moreover, even accepting *ad arguendo* that the use of wobbles taught by Fox is in an important sense the opposite of that recited in claim 12, Examiner disputes that this feature of claim 12 would be a nonobvious difference from the prior art. There are many examples of things being done in both of two opposite ways, e.g. driving on the left in England, but on the right in America, or reading from left to right in English, but from right to left in Hebrew. Nodding the head means yes in some cultures, but no in others. One can write in dark print on a light background, or in light print on a dark background. Thus, using a known means of conveying information to convey opposite information should be considered obvious and not grounds for patentability.

Further reason for believing claim 12 to be unpatentable is found in Linnartz, column 6, lines 54-67. Linnartz discloses that recordable media may carry a fixed mark identifying the medium as recordable (lines 61-62), and that such a mark can be represented by a wobble groove (lines 58-60). Thus, it cannot be considered novel and unprecedented for a recordable medium to have wobbled grooves.

First of all, it is submitted that the fact there many examples of things being done in both of two opposite ways,

such as driving on the left in England, but on the right in America, does not qualify as the motivation required under 35 USC 103(a) to modify the teachings of Linnartz, Yokota, and Fox (the abstract) to provide the combination of a medium dedicated to reproduction having no wobbled grooves and a recordable medium having wobbled grooves recited in claim 12. Rather, it is submitted that there must be some suggestion, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference teachings to obtain the claimed invention.

Here, since Copeland '513, and thus Fox (the abstract) which discusses the DVD antipiracy system disclosed in Copeland disclose that the disk dedicated to reproduction has wobbled grooves, and that the recordable disk has no wobbled grooves, which is exactly the opposite of the situation recited in claim 12 which recites that said medium dedicated to reproduction has no wobbled grooves, and that said recordable medium has wobbled grooves, it is submitted that the Examiner is required to identify some suggestion, either in Linnartz, Yokota, and Fox (the abstract) or in the knowledge generally available to one of ordinary skill in the art, to modify Linnartz, Yokota, and Fox (the abstract) to provide the combination of a medium dedicated to reproduction having no wobbled grooves and a recordable medium having wobbled grooves recited in claim 12. Since the Examiner has not done this, it is submitted that the Examiner has not

established a prima facie case of obviousness with respect to claim 12.

Accordingly, for the reasons discussed above and on pages 55-59 of the Appeal Brief, it is submitted that Linnartz, Yokota, and Fox (the abstract) do not disclose or suggest the combination of a medium dedicated to reproduction having no wobbled grooves and a recordable medium having wobbled grooves recited in claim 12.

CONCLUSION

For the reasons set forth above and in the Appeal Brief, it is respectfully requested that the rejections of claims 1-16 and 24-38 under 35 USC 103(a) be reversed.

Respectfully submitted,

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